

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
10/663,387	09/16/2003	Daniel Easo	2003P11407US
Response To The 11/20/06 Office Action		EXAMINER	
Amendment After Non-Final Rejection		Peaches, Randy	
		ART UNIT	PAGE NUMBER

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REMARKS

Claims 1-26 were pending in this application. In the office action,

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- 1) claims 3, 4, 6, 12-14, 19-21, and 26 were rejected under 35 U.S.C. § 112, ¶ 1, for lack of enablement (office action, p. 2);
- 2) claims 1, 2, 5, 7-10, and 15 were rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent Application Publication No. 2005/0043041 A1 (Ignatius et al.) (office action, pp. 3-6);
- 3) claims 16, 17, 23, 24, and 25 were rejected under 35 U.S.C. § 102(b) as being unpatentable over ETSI TS 123 271 v4.3.0 (2001-10), titled "Digital cellular telecommunications system (Phase 2+) (GSM); Universal Mobile Telecommunications System (UMTS); Functional stage 2 description of location services (3GPP TS 23.271 version 4.3.0 Release 4)," (office action, pp. 6-7); and
- 4) claims 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2005/0043041 A1 (Ignatius et al.) and ETSI TS 123 271 v4.3.0 (2001-10), titled "Digital cellular telecommunications system (Phase 2+) (GSM); Universal Mobile Telecommunications System (UMTS); Functional stage 2 description of location services (3GPP TS 23.271 version 4.3.0 Release 4)," (office action, pp. 8-9).

Claims 1-26 have been cancelled and new claims 27-35 are presented above. An amendment to the specification corrects a typographical error (concerning reference numerals for the BSC 114 and the MSLC 118). Reconsideration is respectfully requested.

The New Claims

New claims 27-31 are directed to a method while claims 32-36 are the apparatus counterparts of the method claims. The applicants submit that the objection and the rejections set forth in the prior action do not apply to the new claims and, therefore, they are not addressed here.

The problem solved by the claimed invention is that of not being able to send or receive calls at the mobile station while a mobile terminating location request is in progress. Specification, p. 3, lines 24-28 ("a heretofore unknown shortcoming within the current wireless

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network standards that forces a MS to wait until the prior MT-LR (started in idle mode) completes, placing the MS on hold for any Mobile Originating (MO) transactions, e.g., an Emergency Call"); Specification, p. 4, lines 31-32 ("MO transactions are allowed to originate and complete even in the presence of an ongoing MT-LR").

The inability to send and receive calls may be overcome by sending a network command, such as a direct transfer application part message or a radio resource location protocol request, to the mobile station. This command is sent to the mobile station while the location request is processed. Figures 2A and 2B; lines 158 and 172, respectively.

In the first figure (2A), after the location request commences (lines 130, 132), and paging and authentication occurs (lines 135-150), the mobile station must receive a network command (line 155) before it can send or receive a call. In this scenario, the network command -- a direct transfer application part (DTAP) message -- is sent by the visited MSC to the mobile station (line 158). The mobile station now has the ability to engage in a transaction, such as a call (lines 160, 162, 164). Specification, p. 6, lines 24-28 (the mobile station "can process the MO request in 160 with a connection management (CM) service request from the MS 106 to the BSC 114. In 162 the BSC 114 forwards the MO request to the MSC 116 to establish and stabilize the MO transaction in 164 without being placed on hold and so, without delaying the MO service request").

In the second figure (2B), the location request also begins on line 130, and again the mobile station awaits a network command (line 155). Here, the network command -- a radio resource location protocol (RRLP) request -- is sent by the base station (or the SMLC) to the mobile station (line 172). The mobile station now has the ability to engage in a transaction such as a call (lines 160, 162, 164). Specification, p. 6, line 34, through page 7, line 5 ("[t]his allows

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the MS 106 to continue the MO request 140 with a connection management (CM) service request 160 from the MS 106 to the BSC/SMLC [[174]] 114/118 without placing the MS 106 on hold and so, without delaying the MO service request. Likewise in 162 the BSC/SMLC [[174]] 114/118 forwards the MO request to the MSC 116 to establish the MO transaction in 164").

Conclusion

The applicants believe that the new claims resolve all of the issues raised in the office action. Further, they believe that the new claims distinguish over the art of record and are therefore allowable. Thus, it is respectfully requested that the examiner pass the application to allowance.

The examiner is invited to call Joel Miller, Esq. (973-736-8306) or the undersigned if there are any questions concerning the application.

Respectfully submitted,



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